

Amendment and Response

Applicant: Mark M. Josephsen et al.

Serial No.: 10/700,075

Filed: November 3, 2003

Docket No.: 100202485-1

Title: PRINTER SECURITY KEY MANAGEMENT

REMARKS

The following Remarks are made in response to the Non-Final Office Action mailed December 19, 2006, in which claims 1-21 were rejected.

With this Amendment, claims 19 and 20 have been cancelled without prejudice, and claims 1-10, 12-14, 16, 18, and 21 have been amended to correct informalities and clarify Applicant's invention.

Claims 1-18 and 21, therefore, remain pending in the application and are presented for reconsideration and allowance.

Specification Objection

The disclosure is objected to because of the following informalities: The Examiner notes that at page 5, line 15 an apparent editing notation "Duplicate?" was not deleted.

With this Amendment, the editing notation "Duplicate?" at page 5, line 15 has been deleted. Applicant, therefore, respectfully request that the objection to the Specification be reconsidered and withdrawn.

Drawing Objection

The drawings are objected to under 37 C.F.R. 1.83(a) as not showing every feature of the invention specified in the claims. More specifically, the Examiner has objected to the drawings as not showing "the security module."

Accompanying this Amendment is a replacement sheet of drawings with a proposed new Fig. 1A. Fig. 1A shows operation of one embodiment of the present invention including "the security module." Support for Fig. 1A is provided in the Specification, for example, at page 3, line 24 - page 4, line 2. Applicant submits that no new matter has been entered with this replacement sheet of drawings.

Applicant, therefore, respectfully requests that the replacement sheet of drawings be accepted, and that the objection to the drawings be reconsidered and withdrawn.

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Claim Objections

Claims 4, 9, 13, 18, 20, and 21 are objected to because of the following informalities: In claims 4 and 13 the Examiner contends that "the symmetric key" lacks antecedent basis. In claims 9 and 18 the Examiner contends that "the attached printer" (line 2) appears to be in error. In claims 20 and 21 the Examiner contends that the preamble and body of the claims contain inconsistent terminology.

With this Amendment, claim 20 has been cancelled without prejudice. The objection to claim 20, therefore, is rendered moot.

With this Amendment, claims 4 and 13 have been amended to depend from claims 2 and 11, respectively, and have been amended to clarify that "the symmetric key" is "the symmetric encryption key", antecedent basis for which is provided in claims 2 and 11, respectively.

With this Amendment, claims 9 and 18 have been amended to clarify that "the attachment between the printer and the attached computer is a network attachment."

With this Amendment, claim 21 has been amended to clarify that the method includes "receiving a message from an attached computer requesting a secure printing key;" "generating a key in response to the received message;" and "sending the key to the attached computer requesting the key."

In view of the above, Applicant respectfully requests that the objection to claims 4, 9, 13, 18, 20, and 21 be reconsidered and withdrawn, and that claims 4, 9, 13, 18, and 21 be allowed.

Claim Rejections under 35 U.S.C. § 101

Claims 1-9 and 19 are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter.

Claims 1, 19, and 20 are rejected under 35 U.S.C. 101 as being directed to neither a "process" nor a "machine", but rather embrace or overlap two different statutory classes on invention set for in 35 U.S.C. 101 which sets forth the statutory classes of invention in the alternative only.

With this Amendment, claims 19 and 20 have been cancelled without prejudice. The rejection of claims 19 and 20 under 35 U.S.C. 101, therefore, is rendered moot.

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With this Amendment, claim 1 has been amended to clarify that the subject matter is directed to "A printer, comprising: a security module within the printer that is operable to: receive a message from an attached computer requesting a secure printing key; generate a key in response to the received message; and send the key to the attached computer requesting the key."

In view of the above, Applicant respectfully requests that the rejection of claims 1-9, 19, and 20 under 35 U.S.C. 101 be reconsidered and withdrawn, and that claims 1-9 be allowed.

Claim Rejections under 35 U.S.C. § 112

Claims 1, 19, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for attempting to claim both an apparatus and the method steps of using the apparatus.

With this Amendment, claims 19 and 20 have been cancelled without prejudice. The rejection of claims 19 and 20 under 35 U.S.C. 112, second paragraph, therefore, is rendered moot.

With this Amendment, claim 1 has been amended to clarify that the subject matter is directed to "A printer, comprising: a security module within the printer that is operable to: receive a message from an attached computer requesting a secure printing key; generate a key in response to the received message; and send the key to the attached computer requesting the key."

In view of the above, Applicant respectfully requests that the rejection of claims 1, 19, and 20 under 35 U.S.C. 112, second paragraph, be reconsidered and withdrawn, and that claim 1 be allowed.

Claim Rejections under 35 U.S.C. § 102 and 35 U.S.C. § 103

Claims 1, 2, 4, 5, 9-11, 13, 14, and 18-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Partelow et al. U.S. Patent Application Publication No. 2004/0008842.

Claims 3, 6, 12, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Partelow et al. U.S. Patent Application Publication No. 2004/0008842 in view of Berstis et al. US Patent No. 6,282,653.

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Claims 7, 8, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Partelow et al. U.S. Patent Application Publication No. 2004/0008842 in view of Lee US Patent No. 6,628,413.

With this Amendment, claims 19 and 20 have been cancelled without prejudice. The rejection of claims 19 and 20 under 35 U.S.C. 102(e), therefore, is rendered moot.

Accompanying this Amendment and Response is a Declaration of Prior Invention under 37 C.F.R. 1.131 to establish conception of the subject matter of the present patent application in the United States prior to the earliest effective date of July 10, 2002 of the Partelow Publication coupled with due diligence from a date prior to the earliest effective date of the Partelow Publication up to the filing date of the present patent application (i.e., constructive reduction to practice). Applicant, therefore, respectfully requests consideration and entry of the Declaration of Prior Invention under 37 C.F.R. 1.131.

In view of the above, Applicant submits that the Partelow et al. U.S. Patent Application Publication No. 2004/0008842 does not qualify as a reference under 35 U.S.C. 102(e) and, therefore, does not qualify as a reference under 35 U.S.C. 103(a). Applicant, therefore, respectfully requests that the rejection of claims 1, 2, 4, 5, 9-11, 13, 14, and 18-21 under 35 U.S.C. 102(e), the rejection of claims 3, 6, 12, and 15 under 35 U.S.C. 103(a), and the rejection of claims 7, 8, 16, and 17 under 35 U.S.C. 103(a) be reconsidered and withdrawn, and that claims 1-18 and 21 be allowed.

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CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1-18 and 21 are all in a condition for allowance and requests reconsideration of the application and allowance of all pending claims.

Any inquiry regarding this Amendment and Response should be directed to either Nathan Rieth at Telephone No. (208) 396-5287, Facsimile No. (208) 396-3958 or Scott A. Lund at Telephone No. (612) 573-2006, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,

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By their attorneys,

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CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 12TH day of March, 2007.

By 

Name: Scott A. Lund